APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,002	10/16/2000	Scott C. Harris	SPAM/SCH	2977

23844 7590 11/03/2004		EXAMINER
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SAN DIEGO, CA 92192	ART UNIT	PAPER NUMBER
	2144	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Office Action Summary	09/690,002	HARRIS, SCOTT C.
	Examiner	**Art Unit**
	Tam (Jenny) Phan	2144

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*03 March 2004 and 28 June 2004*</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,14-16 and 21-24* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,14-16 and 21-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 October 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Amendment A, paper #4, received on 03/03/2004 has been entered into record.

Claims 8-13 and 17-20 are canceled. Claims 14 and 21 are amended. Claims 23-24 are

new. Claims 1-7, 14-16, and 21-24 remain pending.

Priority

2.   This application claims benefit of the provisional application 60/203,729

(05/12/2000).

3.   The effective filing date for the subject matter defined in the pending claims,

which has support in parent 60/203,729 in this application is 05/12/2000. Any new

subject mater defined in the claims not previously disclosed in parent 60/203,729, is

entitled to the effective filing date of 10/16/2000.

Information Disclosure Statement

4.   The information disclosure statement (IDS) filed 02/13/2001 fails to comply with

37 CFR 1.98(a)(2), which requires a legible copy of each publication or that portion

which caused it to be listed; and all other information or that portion which caused it to

be listed. The Non Patent Literature reference cited on IDS (Paper #2, received

02/13/2001 is not present in the application, and thus, could not be considered.

5.   All other references, which were listed, are indicated on the initialed and dated

copy of Applicant's IDS form 1449.

Drawings

6.   This application has been filed with informal drawings, which are acceptable for

examination purposes only. Formal drawings will be required when the application is

allowed.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the
United States before the invention thereof by the applicant for patent, or on an international application
by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
title before the invention thereof by the applicant for patent.

8.   Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Paul (U.S.

Patent Number 5,999,932).

9.   Regarding claim 1, Paul disclosed a method comprising: receiving an electronic

mail message (Abstract, Figures 4, 4A & 6, column 10 line 24); displaying information

about the electronic mail message in a way that allows at least one of deleting the

message without indicating whether it is spam or not [second display code "NEW"]

(Abstract, column 10 lines 41-43), deleting the message while indicating that it is spam

[third display code "JUNK") (Abstract, column 10 lines 47-48), or deleting the message

while indicating that it is not spam [first display code "OK"] (Abstract, column 10 lines

31-32).

10.   Since all the limitations of the claimed invention were disclosed by Paul, claim 1

is rejected.

11.   Claims 14, 16, and 23-24 are rejected under 35 U.S.C. 102(e) as being

anticipated by Nielsen (U.S. Patent Number 6,453,327).

12.   Regarding clam 14, Nielsen disclosed an email program, comprising a display

portion which is display a plurality of e-mails (Figure 4a, column 8 lines 14-43); a

plurality of controls including at least a first control which selects deleting an e-mail

while indicating that said e-mail is spam, and a second control which selects deleting an

e-mail while indicating that said e-mail is not spam (Figure 4b, column 8 lines 14-43).

13.   Regarding claim 16, Nielsen disclosed a program further comprising displaying a

control which allows deleting an e-mail without indicating or not indicating whether said

e-mail represent spam (Figure 4b, column 8 lines 14-43).

14.   Regarding claim 23, Nielsen disclosed a method, comprising: obtaining an

electronic mail message (Figure 4a-4b); and a user interface that displays information

about said electronic mail message (Figure 4a-4b), and which user interface allows a

selection to any of: delete the message without indicating whether or not the message

represents spam (Figure 4b sign 427); delete the message while indicating that the

message does indicate spam (column 4b sign 425) or delete the message while

indicating that the message does not indicate spam (column 4b sign 427).

15.   Regarding claim 24 Nielsen disclosed a method further comprising a database of

information indicating likelihood of spam, and wherein said delete while indicating that

the message does indicate spam updates information in said database (Figure 6,

column 11 lines 43-59).

16.   Since all the limitations of the claimed invention were disclosed by Nielsen claims

14, 16 and 23-24 are rejected.

Claim Rejections - 35 USC § 103

17.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

18.   Claims 2-7 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Paul (U.S. Patent Number 5,999,932) as applied above in view of McCormick et al.

(U.S. Patent Number 6,421,709), hereinafter referred to as McCormick.

19.   Paul disclosed a method comprising: receiving an electronic mail message

(Abstract, Figures 4, 4A & 6, column 10 line 24); displaying information about the

electronic mail message in a way that allows at least one of deleting the message

without indicating whether it is spam or not [second display code "NEW"] (Abstract,

column 10 lines 41-43), deleting the message while indicating that it is spam [third

display code "JUNK") (Abstract, column 10 lines 47-48), or deleting the message while

indicating that it is not spam [first display code "OK"] (Abstract, column 10 lines 31-32).

20.   Regarding claim 2, Paul did not expressly disclose a method further comprising

storing a database of spam likelihood, and wherein said deleting while indicating

updates information in the database. Paul suggested exploration of art and/or provided

a reason to modify storing "not spam likelihood" database with storing "spam likelihood"

database (Figure 6 sign 650, column 9 lines 56-67, column 10 lines 1-11). McCormick

disclosed a method further comprising storing a database of spam likelihood, and

wherein said deleting while indicating updates information in the database (Figure 10,

column 2 lines 62-67, column 5 lines 16-28).

21.   It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to modify the method of Paul with the teachings of McCormick to

include storing a database of spam likelihood in order to offer a more efficient filtering

technique since an incoming e-mail whole addresses are included in the spam database

would be immediately discarded [processed] (McCormick, column 2 lines 55-57).

22.   Regarding claim 3, McCormick disclosed a method wherein said deleting while

indicating update rules in a rules database (column 2 lines 62-67, column 5 lines 16-21,

column 8 lines 48-52).

23.   Regarding claim 4, McCormick disclosed a method wherein said rules include

information about fields from said electronic mail message (column 4 lines 60-65).

24.   Regarding claim 5, McCormick disclosed a method wherein said fields include at

least a sender of the e-mail message, text, of the e-mail message, and a subject of the

e-mail message (Figure 2, column 4 lines 60-65).

25.   Regarding claim 6, Paul disclosed a method wherein said fields also include a

domain of a sender of the e-mail message (column 9 lines 38-45, lines 56-67, column

11 lines 21-23).

26.   Regarding claim 7, McCormick disclosed a method wherein said fields include

links within the e-mail message [advertisement links] (column 6 lines 41-46, column 8

lines 58-65).

27.   Regarding claim 21, Paul and McCormick combined disclosed a method,

comprising determining a plurality of characteristics of an unwanted message (Paul,

Figure 5, column 3 lines 54-65, column 56-67); forming a list with said plurality of

characteristics (Paul, column 4 lines 34-40); forming a numerical score of an incoming

message by comparing said incoming message with said list and determining

commonalities between said incoming message and said list (McCormick, column 5

lines 23-29, column 8 lines 48-65); defining said message as likely being unwanted if

said score is within a predetermined range (McCormick, column 8 lines 48-65); and

taking an action to restrict said message based on said defining (McCormick, column 8

lines 48-65).

28.   Regarding claim 22, Paul disclosed a method further comprising assessing a

common-ness of a domain a sender of a message, and using said common-ness of

said domain (column 11 lines 21-23, column 12 lines 54-61).

29.   Since all the limitations of the claimed invention were disclosed by the

combination of Paul and McCormick, claims 2-7 and 21-22 are rejected.

30.   Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen

(U.S. Patent Number 6,453,327) as applied above in view of Leeds (U.S. Patent

Number 6,393,465).

31.   Nielsen disclosed an email program, comprising a display portion which is

display a plurality of e-mails (Figure 4a, column 8 lines 14-43); a plurality of controls

including at least a first control which selects deleting an e-mail while indicating that said

e-mail is spam, and a second control which selects deleting an e-mail while indicating

that said e-mail is not spam (Figure 4b, column 8 lines 14-43).

32.   Regarding claim 15, Nielsen did not disclose a program further comprising

displaying a likelihood of spam coefficient which indicates, on a weighted scale, a

likelihood that the associated message represents spam. However, Leeds disclosed a

program further comprising displaying a likelihood of spam coefficient which indicates,

on a weighted scale, a likelihood that the associated message represents spam

[confidence rating scale from 0-100%, with 100% being the rating given to a message considered to be junk e-mail or spam] (column 2 lines 26-37, column 6 lines 49-66).

33.   It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the e-mail program of Nielsen with the teachings of Leeds to display the likelihood of spam coefficient in order to help users quickly filter their messages since the user would be able to have the message automatically discarded or have the message marked as potentially junk (Leeds, column 7 lines 18-27).

34.   Since all the limitations of the claimed invention were disclosed by the combination of Nielsen and Leeds, claim 15 is rejected.

Response to Arguments

35.   Applicant's arguments filed 03/03/2004 and 06/28/04 have been fully considered but they are not persuasive.

36.   In response to applicant's argument "there is no teachings or suggestion of anything suggesting different techniques of deleting the email," and "Paul teaches nothing about ways to delete the message" it is submitted that email deleting functionality is inherent in all email systems as evidenced in applicant's response received 06/03/2004 (page 7). Paul disclosed a method that teaches an email interface classified emails into different categories (i.e. junk mail, not junk, etc.). When end users delete the email using the convention delete button, the user is removing the email from their inbox and move the email to the e-mail filter. This is the same as deleting the email from their inbox and indicating that the email is spam, if the email was categorized as spam email, or not spam, if the email was categorized as not spam email.

37.   In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., three different forms of deletion) are not recited in the rejected claim(s). Although

the claims are interpreted in light of the specification, limitations from the specification

are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057

(Fed. Cir. 1993). For instance, claim 1 recites "a method, comprising: receiving an

electronic mail message; displaying information about the electronic mail message in a

way that allows <u>at least one of</u> deleting the message without indicating whether it is

spam or not, deleting the message while indicating that it is spam, <u>or</u> deleting the

message while indicating that it is not spam. The applicant stated that this represents 3

different ways of deleting messages from the mailbox. The claimed limitation read "at

least of" and "or" are not inclusive limitations. Thus, the method does not represent 3

different ways of deleting.

38.   In response to applicant's argument that Nielsen does not disclose a delete as

spam control, a recitation of the intended use of the claimed invention must result in a

structural difference between the claimed invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. If the prior art structure is

capable of performing the intended use, then it meets the claim. In a claim drawn to a

process of making, the intended use must result in a manipulative difference as

compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re*

Otto, 136 USPQ 458, 459 (CCPA 1963). In Nielsen teachings, when users delete their

email using the delete control, they delete their emails as not spam. The examiner is

having a difficult time understanding the functionality differences between "delete an e-

mail while indicating that said e-mail is not spam" in the claimed limitation and the delete control of Nielsen allowing the users to delete their emails as not spam in Nielsen's teachings.

39.   As the rejection reads, Examiner asserts that the combination of these teachings render the claimed invention obvious.

Conclusion

40.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

41.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (571) 272-3930. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (571) 272-3925. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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tp
October 28, 2004